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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,174	06/16/2000	Teruhiko Kori	450100-2828.7	3363
20999	7590	10/13/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			CHEVALIER, ROBERT	
			ART UNIT	PAPER NUMBER
			2616	8

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/596,174

Applicant(s)

KORI ET AL.

Examiner

Bob Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-31 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/094,428.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments with respect to claims 28-31, 33-36, have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 28-30, 33-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,327,109. Although the conflicting claims are not identical, and that the claimed language of the present Application is somewhat different from the language recited in the patented claims 1-5, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that the patented claims 1-5, would be able to perform the functions of the claimed limitations of the present Application. Since, the limitations recited in the claimed invention of the present Application are also recited in the patented claims 1-5, including the feature of loading the recording medium cartridge into a reproducing

With regard to claim 36, the feature of each of the data packets including the level code indicative of the level within the hierarchical structure to which the data packet corresponds as specified thereof is present in the patented claim 4.

4. Claim 31 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,327,109 in view of Kori et al (P.N. 5,786,955).

The patented claim 5 of U.S. Patent No. 6,327,109 discloses a reproducing apparatus that shows substantially the same limitations recited in claim 31 of the present Application, including the feature of the memory device having information stored therein. (See the patented claims 1, and 5).

The patented claims 1, and 5, fail to specifically disclose the feature of the information stored in the memory device as being text data as recited in claim 31 of the present Application.

It is noted that Kori et al (P.N. 5,786,955) does disclose the feature of a recording medium having an associated memory device including text data stored therein. (See claim 5 of Kori et al's Patent No. 5,786,955).

It would have been obvious to one of ordinary skilled in the art the modify the reproducing apparatus shown by U.S. Patent No. 6,327,109, wherein the memory device disclosed thereof would incorporate the capability of storing therein text data in the same conventional manner as shown by Kori et al (P.N. 5,786,955). The motivation is to have stored in the memory device written comment about the signals recorded on

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apparatus (See the patented claim 1, lines 21-22), the feature of transmitting at least some of the information from the memory device included in the recording medium cartridge to the reproducing means and reproducing in accordance with the transmitted information (See the patented claim 5, lines 7-8), the feature of the transmitted information including data identifying at least two of the signals recorded on the recording medium and specifies a predetermined order for the identified signals, the predetermined order being different from the order in which the signals are recorded on the recording medium (See the patented claim 5), and the feature of the information being organized into a structure that includes at least a recording medium information branch and a recording medium content information branch, the recording content information branch including at least two levels as specified in claim 28 of the present Application (See the patented claim 1, lines 6-10), and the feature of the information being stored in the memory device in the form of a plurality of data packets, the size and format of the data packets having been predetermined prior to the storing of the information in the memory device as specified in claim 33 of the present Application. (See the patented claim 1, lines 15-18).

With regard to claims 29, 34, the feature of the recording medium being a tape as specified thereof is present in the patented claim 2.

With regard to claims 30, and 35, the feature of the signals recorded on the recording medium including at least one video signal as specified thereof is present in the patented claim 3.

With regard to claim 36, the feature of each of the data packets including the level code indicative of the level within the hierarchical structure to which the data packet corresponds as specified thereof is present in the patented claim 4.

4. Claim 31 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,327,109 in view of Kori et al (P.N. 5,786,955).

The patented claim 5 of U.S. Patent No. 6,327,109 discloses a reproducing apparatus that shows substantially the same limitations recited in claim 31 of the present Application, including the feature of the memory device having information stored therein. (See the patented claims 1, and 5).

The patented claims 1, and 5, fail to specifically disclose the feature of the information stored in the memory device as being text data as recited in claim 31 of the present Application.

It is noted that Kori et al (P.N. 5,786,955) does disclose the feature of a recording medium having an associated memory device including text data stored therein. (See claim 5 of Kori et al's Patent No. 5,786,955).

It would have been obvious to one of ordinary skilled in the art the modify the reproducing apparatus shown by U.S. Patent No. 6,327,109, wherein the memory device disclosed thereof would incorporate the capability of storing therein text data in the same conventional manner as shown by Kori et al (P.N. 5,786,955). The motivation is to have stored in the memory device written comment about the signals recorded on

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the recording medium in order to better identify the recorded signals at reproduction as suggested in the prior art.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 703-305-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
October 7, 2004.


ROBERT CHEVALIER
PRIMARY EXAMINER